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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,795	03/31/2000	James Link	6446.US.P2	3564

23492 7590 02/27/2002

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EXAMINER
PATEL, SUDHAKER B

ART UNIT	PAPER NUMBER
1624	8

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/541,795	James Link et al
Examiner	**Art Unit**
Sudhaker Patel	1624

-- The MAILING DATE of this communication appears on the cover sh t with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jan 29, 2002*

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-60* is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-60* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

The claims in this application are the claims 1-60.

Applicants' communication paper # 7 dated 1/29/02 is acknowledged.

As applicants are aware, originally this application had claims 1-26. Wide their above mentioned communication, applicants have amended specification pages 2-138 i.e. extensive addition/deletion by 136 pages, amended 1-18, 20-26, and added new claims 27-60 under the pretext of adding clarity &/or correcting typographical errors etc.. This is not true because the specification as amended constituted new matter(s) wherein terms e.g. Aryl, phenyl, heterocyclyl, -NR10 R11 are redefined to increase the scope of the claimed invention. Therefore, new claims 27-60 constituted additions of new matter which was not clearly disclosed in the original applications: ***1).*** Application Sr. No. 09695040 filed 10/24/2000 which is CIP of co-pending instant application No. ***2).*** 09541795 filed 3/31/2000 which is a CIP of ***3).*** 09474517 filed 12/29/1999 now ABN which claims benefit of ***4).*** 60114097 filed 12/29/1998 now expired.

New claims 27-60 together with the amended claims 1-18,20-26 claim subject matter not included in original claims and are therefore broader in scope than the original claims as evident by creation of new Formula III of claims 37-38 independent of claim 1, and therefore, when viewed in totality, are merely duplicates of other claims recited to accommodate the faults and mistakes of above mentioned 1).- 4). Applications together with other US Application # 09222491 filed 12/29/1998 now allowed U.S.P. 6110922 which constituted double patenting aspect also.

From pure chemistry point of view the generic claim 1 Formula I and its genus as recited originally, can not accommodate the applicants claimed molecules and structures by the very limited definitions of the specific Aryl, phenyl, heterocyclyl, -NR10R11 among many other indefinite variables as recited in the original specification. Therefore, applicants intentions are not very clear from the very beginning because instead of limiting the claims, the new addition of claims add more generic and vague components not taken care right at the very beginning.

Applicants' arguments, remarks in the above mentioned response and amendment dated 1/4/02 are considered but not found persuasive for examining the instant application as a single piece under the pretext of improper restriction under the U.S.P. Office rules and regulations.

Compounds having the structures identified in the claim(s) while possessing a single common utility, however, do not represent the same structure because in addition to variations of Formulae as recited by Formula I, II, III representing(where applicable) variables Ar, R10, R11, R1, R2, R3, R4, R5 represent a wide variety of heterocycle, carbocycle/cycloalkyls varying from phenyl, homopiperidine, pyrimidine,pyridine, imidazole,furyl,benzimidazolone, 1,4-benzodioxane, 1,3-benzodioxole, benzopyr-2-en-4-one, indole, isatin, quinazoline, quinoline and others will involve more than a single class of compounds according to the U.S. Patent Classification system. This when coupled with utility class 514 and the spiro-structures which will further involve multiples of subclasses in each group. Thus, variations in Ar, R10, R11 together with multiple choices as recited for variables R1,R2,R4,R5 simultaneously representing cis/trans-cinnamide core with -NR10/R11 in addition to R3 position, will produce patentably

distinct non-equivalent compounds which could be made and used independently. The inventions are distinct, each from the other because they have acquired separate status in the art, and will require different field of search. Therefore, restriction for examination purposes, as indicated is considered proper based on sound scientific grounds.

37 CFR 1.141(a) provides that two or more independent and distinct inventions may not be claimed in one application. When a group of compounds are subject to the test of 37 CFR 1.141(a) provides that two or more independent and distinct inventions may not be claimed in one application. When a group of compounds are subject to the test of patentability, the whole molecule must be considered. One can not classify and examine concepts based on bits and pieces of the molecule, that is carved out of the whole compound. The variations of Ar, R10/R11 in Formula if claim 1 produce different entities that is presently multiple search areas. Pyridines and pyrimidines do not form a single inventive concept within the meaning of 35 U.S.C. 121 because a reference that anticipates or renders obvious one of the groups would not necessarily render obvious another group and applicants have not clearly stated on the record that this is not the case.

It is regretful that applicants will have to file divisional applications for desired protection. However, without restriction/election, an effective and complete search cannot be accomplished in the limited time available for a through examination of the entire content(s) of the invention(s). Applicants are also reminded that usually a patent protection is sought for a single invention only.

The special technical feature is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art(s).

The feature is, thus, not special if it is known. That what is common here is the **1).** Ar-S-Phenyl i.e diarylsulfide core having R1-R5 substituents which does not represent patentable advances over the prior art(s) already known(see co-pending application Sr. # 09541795;EP 219756;DE 2123383 which recites phenythiopheny core). The claims are drawn to making of structurally dissimilar compounds which are classified separately, require separate literature searches and are not art recognized equivalents. They are made and used independently e.g. variation in values of Ar, R1-R5 together with the substituents.

Furthermore, if say, compounds of Group I were anticipated, applicants would not Furthermore, if say, compounds of Group I were anticipated, applicants would not acquiesce in the rejections of the other groups there over or vice-versa. They are patentably distinct.

Therefore, it is too burdensome for the office to Examine several inventions in one application. Applicants are entitled for a single invention, not multiple inventions in one application. See In re Youg, 81 USPQ 139.

Note that compounds, corresponding simple compositions, a method of use and the first recited process of making a simple composition that are of the same scope are considered to form a single inventive concept. The species as presented by various groups and either compounds or their derivatives as recited by generic Formulae I, II, III are not so linked as to

form a single inventive concept. The compounds are so diverse in scope that a prior art of making it or its composition and using the same further as a pharmaceutical which is anticipated under 35 U.S.C. 102 would not render obvious another compound of the same claim 35 U.S.C. 103.

Ex parte Markush, 1925 C.D. 126, provided for this claim structure where there was an emergency engendered need, as the substances were so " closely related that they would not support a series of patents".

As already discussed earlier, CFR 1.141(a) provides that two or more independent and distinct inventions may not be claimed in one application. In one application means in one application, whether or not the misjoinder occurred in one claim or more than one claim.

This is consistent with PCT Rule 13.3: " 13.3 Determination of Unity of invention Not Affected by Manner of claiming".

The determination whether a group of invention is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim".

Where restriction is going to be exercised is where independent and distinct inventions are presented in one Markush grouping.

Independent means the compound is capable of being utilized alone, not in combination with other compounds listed in the Markush expression; MPEP 802.01.

In addition to above facts, applicants are reminded again that invention simple compositions employing a compound alone or its pharmaceutically-acceptable salt or prodrug thereof of generic Formulae I, II, III according to independent claims 1, 24, 37, 47/48/49, dependent claim 51 reciting newly created Formula III, claim 52 and other dependent generic claims together with auxiliaries and additives will be classified in utility class 514, subclasses various as determined by the nature of components including prodrugs for which applicants remain silent.

However, upon further review and reconsideration the restriction/election requirement is further modified in the following way:

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims(in part) 1-23, drawn to compounds, simple compositions, method of use and the first recited process of making generic Formula I wherein Ar, R10, R11 are aryl, alkyl, chains, but ***not*** Heterocycle, classified in classes ***558-568***, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this group is elected further restriction/election will be required, and furthermore ***a single*** species for the elected invention with exact and specific values for Ar, R1-R5, R10/R11 will be required.

II. Claims(in part) 1-23, drawn to compounds, simple compositions, method of use and the first recited process of making generic Formula I wherein **Ar** = 6 membered heterocycles having only 1 N i.e. piperidine, pyridine, quinoline; -**NR10/R11 = form 6-membered heterocycle** together with N (NR10R11 forming closed structure), or 6-membered heterocycles having 1 N, and additionally 1-3 heteroatoms e.g. pyrimidine, 1,4-diazine, triazine, morpholine, thiomorpholines etc., and their benzo-fused forms (i.e. No Nitrogen); **R3** ***only*** = cinnamide, classified in class ***544***, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, R1,R2,R4-R5, R10/R11 will be required.

III. Claims(in part) 1-23,27-36, drawn to compounds, compositions, method of use and the

first recited process of making generic Formula I wherein Ar= other heterocycles not included in above Group II; -N R10/R11= **form heterocycle**s not included in above Group II and represent homopiperidine classified in class ***540***, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this group If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, R1-R5, R10/R11 will be required.

IV. Claims(in part)1, 24,25, drawn to compounds, compositions, method of use and the first recited process of making generic **Formula II** wherein classified in class ***562***, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, R1-R5, R10/R11 will be required.

V. Claims(in part) 27- 60, drawn to compounds, compositions, method of use and the first recited process of making generic **Formula III** classified in various classes and subclasses various depending on the nature of various substituents Ar, R1, R2, R3, R4, R5 etc. If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, R1-R5, R10/R11 will be required.

VI. Claims(in part) 1-23 where applicable, drawn to compounds, simple compositions, a method of use and the first recited method of making composition of generic Formula I wherein R3 ***is other than cinnamide link***, classified in various classes , subclasses various depending on the nature of the variables. If this group is elected, further restriction/election will be required as there are many unknowns.

In addition to election of one of the above groups, applicants are further required to elect a single species with definite variables embracing the elected group in reply to this Office Action.

2. The inventions are distinct, each from the other because of the following reasons: Inventions are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(I)).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for other Groups, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed inventions: Formulae I, II and III when considered from the variables (where applicable) AR, R1-R5 which could be either substituted or unsubstituted will provide multiples of products with wide variety of structures which will be non-equivalent to each other.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1,24,37,47,48,49,52 are generic.

Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicants have elected with traverse the species as represented by Compound 423 B specification page 383 which has a generic core: " 6-membered heterocycle(piperidine)-phenyl-S-phenyl-CH=CH CO-^-membered heterocycle(1,4-0xazine)". This compound falls in above Group II Claims(in part) 1-23, drawn to compounds, simple compositions, method of use and the first recited process of making generic Formula I wherein **Ar** = 6 membered heterocycles having only 1 N i.e. piperidine, pyridine, quinoline; -**NR10/R11 = form 6-membered heterocycle** together with N (NR10R11 forming closed structure), or 6-membered heterocycles having 1 N, and additionally 1-3 heteroatoms e.g. pyrimidine, 1,4-diazine, triazine, morpholine, thiomorpholines etc., and their benzo-fused forms (i.e. No Nitrogen); **R3 *only*** = cinnamide, classified in class ***544***, subclasses 106,253,283; class 514 subclasses 295, 395.415,712. Further restriction/election will not be required at this stage.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1-60 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1- 19 of prior US application Sr. # 6110922 filed 12/29/1998 now U.S.P. 6110922. This is a double patenting rejection.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-60 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-70 of copending Application No. 09695040 filed 10/24/2000. Although the conflicting claims are not identical, they are not patentably distinct from each other because applicants have tried to claim new

matter(s) by way of addition of Formula III to expand the scope of the specification as well as claims under the pretext of adding clarity. The claims are merely duplicate form of the application(s).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 U.S.C. § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-60 are rejected under 35 U.S.C. 112 first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not give any guidance as to the method for suppressing immune response by way of inhibitory activity in an ICAM-1/LFA-1 biochemical interaction or ICAM-3/JY-8 cell adhesion for treating a mammal suffering from a generic inflammation disorder which could be treated using instantly claimed step of administering a composition comprising a compound selected from claim 19 or 47.

In evaluating the enablement question, several factors are to be considered. In re Wands, 8 USPQ 2d 1400 (Fed. Cir. 1988); Ex parte Forman, 230 USPQ 546. The factors include:

(1). The nature of invention,

(2). the state of prior art,

(3). the predictability or lack thereof in the art,

(4). the amount of direction or guidance present,

(5). the presence or absence of working examples,

(6). the breadth of the claims,

(7). the quantity of experimentation needed, and

(8). the level of the skill in the art.

In the instant case, Applicants are claiming a method or a composition for a method for suppressing immune response by way of inhibitory activity in an ICAM-1/LFA-1 biochemical interaction or ICAM-3/JY-8 cell adhesion for treating a mammal suffering from a generic inflammation disorder. The nature of the pharmaceutical art(s) is that it involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities. There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any medicinal or therapeutic regimen on its face. The instant specification does not give any guidance as to the full range of treatment involving use of derivatives of diarylsulfide by using the instantly claimed step of administering a compound or composition of claims 19 or 47. In order to practice the claimed invention, one skilled in the art would have to speculate which disease could be treated by using the claimed

derivatives found in the instant claim 4. The number of possible diseases &/or conditions embraced by the claims would impose undue experimentation on the skilled art worker. Therefore, the broad terminology is not enabled because the metes and bounds of the diseases which could be treated by using the derivatives found in the instant claims and the same can not be ascertained.

Applicants' attention is drawn to MPEP 806.05(h) which provides for one method of use to be examined with the elected compounds. A broad disclosure of utility as in the cited claims 20-23, 48-51 can not be deemed in compliance with 35 U.S.C. 112, first paragraph.

This requirement of one specific utility is also in compliance with 37 CFR 1.475 the unity of Invention Practice in International Applications and National Phase Applications under U.S.C. 371, and PCT Rule 13.2.

Therefore, applicants should limit the method claim to a sole "specific utility", and provide necessary supporting evidence for the same by appropriate tests which should include the corresponding reference compounds which are not included in the present screening

Claim Rejections - 35 U.S.C. § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over A. Franke et al(Helv. Chim. Acta Vol.58 Fasc.1 pages 268-278(1973).

The instant application is related to making of substituted bisarylsulfide or diarylthioether compounds involving R1-R5 all substituents = R3 = trans or cis cinnamide side chain as recited in generic claim 1 by a generic Formula (I).

Applicants further claim preparation of composition(s) for a method for suppressing immune response by way of inhibitory activity in an ICAM-1/LFA-1 biochemical interaction or ICAM-3/JY-8 cell adhesion for treating a mammal suffering from a generic inflammation disorder.

The ref.Franke et al teaches making of substituted biaryl/phenyl thioethers as evident from Table 1 compound No. 47 wherein specifically R = thiophenol, and R' = COOCH3. The ref. defers from the instant application by not having the heterocycle substituted at the end of cinnamic acid-COOH group modified as listed in instantly claimed compound and species. However, the ref. Also teaches alkoxy substitution on to phenyl(see Table I compound # 36 on page 273) AND ALSO MODIFICATION OD -COOH GROUP INTO -CON(ALKYL)2 (SEE COMPOUND # 43 AND OTHERS OF THE TABLE I ON PAGE 273 AS WELL) and additionally, it also teaches the use of compounds having Juvenilhormone activity.

Thus, it would have been obvious to one having ordinary skill in the art at the time of invention to prepare instant compounds by modifying the core of generic Formula of reference Franke et al which teaches the use of Diarysulfide core having pharmacological activity, and

prepare derivatives by putting/ inserting extra rings structures including heterocycles in either one or both of the phenyl rings as claimed herein and make the compounds as claimed herein, and also tryout the use/utility different or similar to reference Franke et al by using the conventional chemistry knowledge of synthesis of heterosubstituted biarylsulfides. The motivation stems from the expectation of making compounds having equal or better pharmacological activity but also compositions for treating inflammation and conditions/diseases as recited herein.

It has been held that a prior art disclosed compounds is sufficient to render a prima facie case of obviousness as species falling within a genus. See In re SUSI, 440 F 2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by Federal Circuit in Merck & co. V. Biocraft Laboratories, 847 F 2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir.1989).See In re Dillon 16 USPQ 2nd. 1897, 1923 regarding a prima facie case of obvious ness of structurally similar compounds disclosed by prior art" regardless lo the properties disclosed in the inventor's application.

All this is especially considered so in the absence of timely, verified, comparative data, commensurate in scope to the claims sought, clearly and convincingly proving obvious ness over the art(s) as applied above. If applicants intend to rely on unusual or unforseen results demonstrate patentability, attention is drawn to MPEP 716. It is also pointed out that arguments of patentability to differences either not in, or not made clear by, claim language will be of no avail as it is the claims, per se, that are the measure of the invention.

This application has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is, therefore, requested in promptly correcting any errors of which they may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel,D.SC.Tech. whose telephone number is (703) 308 4709. The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Dr.Mukund Shah can be reached at (703) 308 4716.

A facsimile center has been established for Group 1600. The hours of operation Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 1235.

Mukund J. Shah

MUKUND J. SHAH
SUPERVISORY PATENT EXAMINER
GROUP 1600

sp

February 24, 2002.